



REPLY UNDER 37 C.F.R. 1.116 – EXPEDITED PROCEDURE
TECHNOLOGY CENTER 1773

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit	: 1773	Customer No.: 035811
Examiner	: Sheeba Ahmed	
Serial No.	: 10/628,817	
Filed	: July 28, 2003	
Inventors	: Hideki Ozawa	Docket No.: 1259-03
	: Fumio Aoki	
Title	: ANTISTATIC FILM AND PROCESS	Confirmation No.: 5866
	: FOR ITS MANUFACTURE	
		Dated: November 8, 2006

REPLY UNDER 37 C.F.R. 1.116 – EXPEDITED PROCEDURE
TECHNOLOGY CENTER 1773

Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is submitted in response to the October 18, 2006 Advisory Action.

The Applicants note with appreciation the Examiner's helpful comments on the last page of the Advisory Action with respect to the amendments to the Specification. In particular, the Advisory Action states that: "The proposed amendments to the Specification introduce new matter and hence will not be entered." The Applicants respectfully submit that the amendments in no way introduce new matter to the Specification. The new amendments are made merely for clarification purposes so that the disclosure that is repeated throughout the Applicants' Specification is even more readily apparent to one skilled in the art.

The Advisory Action also specifically states that:

The Examiner maintains [sp] that the amendment adding that the antistatic film comprises a polyimide film having "no conductive ultrafine particles" is a negative limitation and any negative limitation or exclusionary proviso must have basis in the original disclosure.

The Applicants respectfully submit that "no conductive ultrafine particles" highlighted in the Advisory Action is word for word disclosed in the original application as filed. That word for word

disclosure may be found in the same paragraph in which the other amendments were made. Specifically, the actual words “no conductive ultrafine particles” are explicitly set forth on Page 8 of the Applicants’ Specification on Line 19. The Applicants are at a loss as to understand why there is a belief that there is no direct support for that language.

The additional comments in the Advisory Action that:

The phrase ‘no conductive ultrafine particles’ is a negative limitation and any negative limitation or exclusionary proviso must have basis in the original disclosure. Applicants are reminded that the mere absence of a positive recitation is not basis for an exclusion.

The Applicants agree that “no conductive ultrafine particles” is a negative limitation. The Applicants also agree that any negative limitation should have a basis in the original disclosure. The point here is that the exact words are in fact present in the original disclosure on Line 19 of Page 8.

The Applicants also respectfully submit that one skilled in the art can readily understand, based on the entirety of the disclosure, including the examples, that the second full paragraph on Page 8 of the Applicants’ Specification refers to an antistatic film that has a polyimide film layer that has no conductive ultrafine particles and a metal oxide and conductive ultrafine particle mixed layer formed on a surface of the polyimide film. In other words, there is a polyimide film adjacent the metal oxide and conductive ultrafine particle mixed layer. The polyimide film has “no conductive ultrafine particles.” The Applicants’ last Response filed on September 27, 2006 provides a detailed recitation of the locations in the Specification that one of ordinary skill in the art can easily see supports the disclosure of an antistatic film comprising a polyimide film with no conductive ultrafine particles as one layer and a metal oxide in conductive ultrafine particle mixed layer adjacent the polyimide film layer.

The Applicants' amendments to that second full paragraph on Page 8 are nothing more than a clarification of that fundamental basis of the entire disclosure when it is fairly read in the proper context.

This application was originally written in Japanese and translated into English. There are times when such translations, because of the nature of the Japanese language, do not provide the type of precision often found in English language text. That is the case here and the Applicants' amendments are nothing more than a clarification, in a more precise manner, of the readily discernable disclosure of the original application as filed when it is fairly read by one skilled in the art.

As such, the Applicants respectfully submit that the proposed amendments to the Specification do nothing more than clarify the disclosure that was already present in the original application. Withdrawal of the objection based on new matter is respectfully requested and withdrawal of the previous rejection under 35 U.S.C. §112 is also respectfully requested.

Respectfully submitted,



T. Daniel Christenbury
Reg. No. 31,750
Attorney for Applicants

TDC/as
(215) 656-3381